

REMARKS

Claims 2-4, 6-8, 10, 11, 13-18 and 21-37 are pending in the instant application and stand rejected. Claims 2, 3, 13, 14, 21, 24, 26, 27, 30, 32, 35 and 36 have been amended. Support for the Amendment can be found, for example on Page 6, of the specification, among other portions of the instant application. Applicants respectfully request reconsideration and allowance of the pending claims.

Applicants respectfully request consideration of all of the pending claims. All of the pending claims are directed to the same group. Such action is respectfully requested.

The rejection of Claims 2-4, 6-8, 10, 11, 13-17 and 20 as being unpatentable over JP 54-33542, Lyons Jr. (USPN 5,263,287), Heimann et al. (USPN 6,017,857), Nee (USPN 4,983,449), Karim et al (USPN 6057382), and Glorieux (USPN 5,399,189), is respectfully traversed.

The instant rejection relies upon 6 references. In order to support a prima facie case of obviousness, the Office Action must establish that there is motivation to combine all of these references together; not that one reference is combinable with a single reference (and yet incompatible with the remaining references). Prima facie obviousness requires considering properly combined references as a whole not as redacted or selected portions (i.e., it is improper to "pick and choose" certain portions of applied references). When considering all of the applied references as a whole, Applicants respectfully submit that the Office Action has not established the motivation to combine all of these references and how such motivation is capable of overcoming inconsistent teachings in these references.

JP '542 discloses an anti-rust composition having a grease base agent. In contrast, the claimed composition comprises a tape, sheet or film. A skilled person in this art would not equate a grease, which lacks any defined three dimensional quality, to a reinforced tape, sheet or film. That is, the function and utility of a grease and a tape are not interchangeable. Similar to JP '542, Heimann is directed to a corrosion resistant lubricant, grease or gel; not a tape, sheet or film.

JP '542 discloses using INERT siliceous fillers. In contrast, the silicates of Heimann are not limited to the inert siliceous fillers of JP '542. That is, the silicates of Heimann are active and can impart increased pH or buffering qualities and, therefore, are not inert as clearly taught by JP '542 (e.g., compare Col. 3, Line 62-Col. 4, Line 2 of Heimann to the inert siliceous fillers of JP '542). In light of the inconsistent siliceous materials, a skilled person in this art would lack the

requisite motivation to combine JP '542 and Heimann. The Office Action has not established how inert siliceous fillers are equivalent to active buffering materials and how such equivalency is transferred from a grease to a tape. The standard for combining JP '542 and Heimann is not whether Heimann's silicates "can be" added to JP '542; but whether is there sufficient teaching in these references that discloses, teaches or suggest such an addition or a substitution.

Nee discloses a protective wrapping material. A skilled person in this art would not equate JP '542's or Heimann's grease to Nee's tape. That is, a grease is applied in a manner distinct from a tape, has no independent configuration, among other functional and chemical differences. Note also that Nee is concerned with the electrical conductivity of his wrapping material and requires porosity to achieve adequate cathodic protection (e.g., refer to Col 3, Lines 1-5, Col. 4, Lines 59-63, and Col. 6, Lines 30-35 of Nee). The grease of JP '542 lacks any disclosure relating to porosity or conductivity.

The combination requires modifying JP '542 or Nee. Converting Nee to a grease or JP '542 to a tape would destroy the respective physical characteristics of the products disclosed in these references (i.e., the presence or absence of a defined three-dimensional structure is mutually exclusive-refer to **MPEP 2143.01**). Consequently a skilled person in this art would not consider Nee as being analogous art to JP '542. Assuming arguendo that Nee and JP '542 are analogous art, Nee relates to protecting a buried metallic pipe (e.g, Col. 1, Lines 1-10 of Nee) whereas JP '542 teaches treating constructions exposed to direct sunlight. Such different applications would cause a skilled person in this art to lack the requisite motivation to combine JP '542 and Nee.

The Office Action indicates that Nee is relied upon to teach a support backing. Such reliance does not permit disregarding the whole reference. The Office Action has failed to establish why a person having ordinary skill in this art, when considering all of the applied references as whole, would combine these applied references (e.g., why would a skilled person equate grease with a tape?).

Karim et al. is not available under 35 USC 102(b) against the instant claims. Applicants reserve the right to challenge Karim as being prior art against the claimed invention under 35 U.S.C. 102(e).

Glorieux relates to a low porosity anticorrosion composition having barrier properties (e.g., refer to the Abstract and Col. 1, Lines 30-35 of Glorieux). In contrast, Nee teaches the value of having porosity so that the underlying pipe can be cathodically protected. The teachings of Glorieux and Nee are clearly conflicting and, therefore, a combination including Glorieux and Nee is inappropriate. The Office Action states that Glorieux is relied upon for teaching of microparts. Such reliance does not permit disregarding clearly inconsistent disclosures relating to porosity.

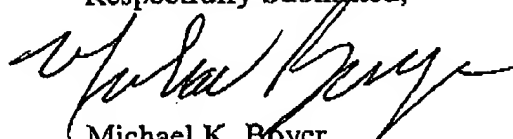
JP '542 and Heimann contain conflicting disclosures, JP '542, Heimann and Nee are inconsistent, and Glorieux and Nee teach away from each other. For these reasons, Applicants respectfully submit that a skilled person in this art, when

considering these references as a whole, would lack the requisite motivation to combine these references. Accordingly, Applicants respectfully submit that the applied references cannot be combined to establish a prima facie case of obviousness and, therefore, request withdrawal of this rejection.

This Application is also related to continuing patent application Serial No. 10/375,555 filed on February 26, 2003 (confirmation no 9127). Applicants respectfully request consideration of this patent application as well as the references cited therein.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability. Please find attached hereto a Request For Continued Examination (RCE) Transmittal. Should there be any other fee due in connection with this application, please charge the same to Deposit Account No. 15-0680 (ORSCHELN MANAGEMENT CO.). Should the Examiner deem that any further action on the part of Applicants would advance prosecution, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,



Michael K. Boyer  
Attorney for Applicants  
U.S.P.T.O. Reg. No. 33,085  
Tel: 660 269-4536  
Fax: 660 269-4530  
mboyer@orscheln.com

Encl.: Request For Continued Examination (RCE) Transmittal  
Certificate of Facsimile Transmission Dated: November 28, 2003